



UNITED STATES DEPARTMENT OF COMMERCE
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SERIAL NUMBER	FILED DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
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FMS1/0430

EXAMINER	
MILLER, E	
ART UNIT	PAPER NUMBER
3641	19

DATE MAILED: 04/30/99

Below is a communication from the EXAMINER in charge of this application
COMMISSIONER OF PATENTS AND TRADEMARKS

ADVISORY ACTION

☒ THE PERIOD FOR RESPONSE:

- a) ☐ is extended to run _____ or continues to run _____ from the date of the final rejection
- b) ☒ expires three months from the date of the final rejection or as of the mailing date of this Advisory Action, whichever is later. In no event however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

☐ Appellant's Brief is due in accordance with 37 CFR 1.192(a).

☒ Applicant's response to the final rejection, filed 4/16/99 has been considered with the following effect, but it is not deemed to place the application in condition for allowance:

1. ☒ The proposed amendments to the claim and /or specification will not be entered and the final rejection stands because:
- a. ☒ There is no convincing showing under 37 CFR 1.116(b) why the proposed amendment is necessary and was not earlier presented.
- b. ☒ They raise new issues that would require further consideration and/or search. (See Note).
- c. ☐ They raise the issue of new matter. (See Note).
- d. ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
- e. ☐ They present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE:

The change in claim 1 raises a §112 question of whether the step is sequential or possibly may be combined in the following step. This would clearly require reexamination.

2. ☐ Newly proposed or amended claims _____ would be allowed if submitted in a separately filed amendment cancelling the non-allowable claims.
3. ☒ Upon the filing an appeal, the proposed amendment ☐ will be entered ☒ will not be entered and the status of the claims will be as follows:

Claims allowed: _____

Claims objected to: _____

Claims rejected: 1 E 10

However:

☐ Applicant's response has overcome the following rejection(s): _____

4. ☐ The affidavit, exhibit or request for reconsideration has been considered but does not overcome the rejection because _____

5. ☐ The affidavit or exhibit will not be considered because applicant has not shown good and sufficient reasons why it was not earlier presented.

☐ The proposed drawing correction ☐ has ☐ has not been approved by the examiner.

☒ Other *See next page.*

Art Unit: 3641

1. On the question of the species election: Applicant will observe that "source material" is not a single species, such as uranite, or tailings from HCl-leached fluorapatite, e.g. Similar observations may be made about other parts of the ostensible single ultimate species. "First acid" is generic to hydrochloric acid, sulfuric acid, etc., etc. "Any fluorine values present" is obviously generic to two possibilities, present or absent. In short, the ostensible single ultimate species elected fell short of meeting the dictionary meaning of "ultimate", e.g., that which cannot be further divided. Since the response had been previously found non-responsive, the alternative to acting on the case as was done would have been to hold the case abandoned for failure to take such full and proper action as the case required. Instead, the case was acted upon per se, with applicants being held to what they elected as the ultimate species. A genus per se not being an ultimate species, any claims that further limited the "ultimate" species would be non-elected. Alternately, arguments that claims further limit the elected species would be an admission that applicant willfully failed to comply with the previous ultimate species election, warranting holding the case abandoned for failure to take full and proper action.

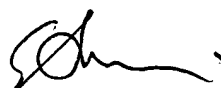
As to the question of species: Depending on the starting material, the leaching agent and conditions, the desired metal value, additional metal values recovered, specific steps as precipitation of detritus, removal of off gases, and so on, about half of the subclasses of class 423 would require search, so the election was clearly warranted. Should applicants desire to modify their election, or otherwise change the invention to be examined, they are urged to file a CPA divisional application whereby the elected species will not be fixed by the prior election.

2. Any inquiry concerning either this or an earlier communication from the Examiner should be directed to Examiner Edward A. Miller at (703) 306-4163. Examiner Miller may normally be reached daily, except alternate Fridays, from 8:30 AM to 6 PM.

If attempts to reach Examiner Miller by telephone are unsuccessful, his supervisor Mr. Jordan can be reached at (703) 306-4159. The Group fax number is (703) 305-7687.

If there is no answer, or for any inquiry of a general nature or relating to the application status, please call the Group receptionist at (703) 308-1113.

Miller/em
04/29/99



EDWARD A. MILLER
PRIMARY EXAMINER